.IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

VULCAN GOLF, LLC, JOHN B. SANFILLIPPO & SON, INC., BLITZ REALTY GROUP, INC., and VINCENT E. "BO" JACKSON, individually and on behalf of all others similarly situated,	§	
Lead Plaintiffs,	§	Civil Action No.: 07-C-3371
v.	§	Hon. Blanche M. Manning
	§	Magistrate Geraldine Soat Brown
GOOGLE INC., OVERSEE.NET, SEDO LLC, DOTSTER, INC., a/k/a REVENUEDIRECT.COM, INTERNET REIT, INC. d/b/a IREIT, INC., and JOHN DOES I-X,	§	
Defendants.	§	

PLAINTIFFS' RESPONSE TO DEFENDANTS' CONSOLIDATED SUR-REPLY

Plaintiffs respectfully submit the following response to Defendants' Consolidated Sur-Reply to Plaintiffs' Motion for Class Certification (hereinafter "Sur-Reply") [D.E. No. 227].

ARGUMENT

In their Sur-Reply, defendants abandon many of their original arguments. By so doing, they acknowledge that the Modified Original Class and Registered Domain Class resolve most of their original concerns. None of defendants' remaining arguments (new or old) defeat class certification.

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I. Proxy Companies/Information Matching

Defendants argue at length that the purported "difficulty and cost" of obtaining certain proxy company information should defeat certification of the Registered Domain Class. If necessary, plaintiffs are willing to commit the time and resources required to obtain registration information from proxy companies. Moreover, defendants ignore the fact that any Class members who cannot be identified by matching domain registration information can be notified by an appropriate publication notice program. *See, e.g., In re Prudential Sec. Inc. Ltd. P'ships Litig.*, 164 F.R.D. 362, 368 (S.D.N.Y.1996) (approving individual notice to class members "whose address could reasonably be located" and summary notice published twice in national editions of the Wall Street Journal, New York Times, and U.S.A. Today), aff'd mem., MDL No. 1005, 107 F.3d 3, 1996 WL 739258 (2d Cir. Dec. 27, 1996). Finally, defendants ignore the fact that the Court could limit that Class to only those individuals and mark owners who have registered their domains in their own names or through domestic proxy companies.

Defendants also suggest that automated matching would be impossible. Defendants are wrong. Matching programs often employ "fuzzy searching," which looks for close (though not identical) matches. *See, e.g.,* http://whatis.techtarget.com/definition/0,,sid9_gci1075268,00.html ("A fuzzy matching program can compensate for common input typing errors, as well as errors introduced by optical character recognition (OCR) scanning of printed documents."). Such software would not be tripped up by the minor differences between "John B. SanFilippo" and "John P. SanFilippo & Son, Inc." Moreover, sophisticated address software programs are available to detect changes of address. *See, e.g., Parker v. Time Warner Entertainment Co., L.P.*, 239 F.R.D. 318, 327 (E.D.N.Y. 2007) (noting that list of class members "was updated through the National Change of Address database, which makes change of address information available"). The fact that parties as technologically sophisticated as these defendants have resorted to claims of technological complexity serves only to highlight the absence of any real arguments undermining the clear appropriateness of class certification.[1]

II. Mark Ownership

Defendants still give no reason to disregard the holding that when defendants engage in a massive online scheme, the resulting common questions of law and fact predominate over any individual ownership issues. *In re Napster*, 2005 WL 1287611, *7 (N.D. Cal. 2005) ([W]hile it is true that proof of ownership . . . ultimately requires a work-by-work inquiry, viewing these determinations as purely 'individual issues' ignores the fact that the claims of every member of the class are uniformly premised upon the uploading or downloading of a copyrighted work by Napster users."). This is particularly true where, as here, a prima facie case of ownership can be made from PTO records.

III. Distinctiveness/Famousness

Defendants devote significant space to arguing that the presumption of distinctiveness that arises from registration of a mark is weak, and describing for the first time possible ways in which they might challenge that presumption. (Sur-Reply at 11-12). Notably, not a single one of the cases cited by defendants on the issue of distinctiveness is an ACPA case, and none of them address the issue of determining distinctiveness or famousness for ACPA purposes through registration of multiple confusingly similar sites.[2] Moreover, registration of multiple confusingly similar domain names (a factor considered by this Court in *Avlon*) would logically trump any evidence that defendants might use in their attempts to challenge distinctiveness or famousness – and defendants cannot and do not refute that point.[3] For example, having parked at least nine different domains confusingly similar to "vulcangolf.com" (TAC at ¶65), defendants cannot plausibly claim that plaintiff's "vulcan" mark for golf clubs is not distinctive. In any event, the question of whether registration of multiple domains is the best evidence of distinctiveness in this context is a common question that can be resolved on a class basis.

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[1] As defendants correctly point out, Bo Jackson would not be a member of the Registered Domain Class. Should the Court narrow the originally proposed Class to require domain registration, plaintiffs would seek leave of Court to substitute a new class representative for Mr. Jackson, and would pursue Mr. Jackson's claims on an individual basis.

IV. No Individual Examination of Sites

Defendants are simply wrong regarding sites that pre-pend "www" or "http" or post-pend "com." First, plaintiffs did not suddenly "concede" in their response that sites like "httpguru.com" and "bearcom.com" do not violate the ACPA. Rather, it has been clear from the opening brief that the Class (or any sub-class or variation thereof) includes only defendants' parked (*i.e*, advertising only, non-content) sites. *See* Opening Brief at 5 (incorporating term "parked" into original Class definition). Moreover, the identities of all sites that have been

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2 Instead, they are all traditional trademark infringement cases. *See Custom Vehicles, Inc. v. Forest River, Inc*., 476 F.3d 481 (7th Cir. 2007); *Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934 (7th Cir. 1986); *Donald F. Duncan, Inc. v. Royal Tops Mfg. Co.,* 343 F.2d 655, 659-68 (7th Cir. 1965), and all of the cases cited in footnote 4 of defendants' Sur-Reply.

3 Defendants falsely argue, instead, that this Court found distinctiveness in *Avlon* based on numerous facts, including the plaintiffs' worldwide sales, the percentage of defendants' sales made up of plaintiffs' products, and the prominence of plaintiffs' products relative to competing brands. (Sur-Reply at 13). However, those factors appear in the Court's analysis of famousness (rather than distinctiveness) and are not even raised until after the Court has already resolved the distinctiveness issue on the basis that the "actions" of registering multiple variations of the mark "speak louder than words." *Avlon Industries v. Robinson*, 2005 WL 331561 at *2 (N.D. Ill. Feb. 8, 2005).

parked by defendants at any point in time are known to defendants and can be easily identified in discovery. Thus, defendants' arguments that plaintiffs' "proposed rules do not work" and thus that "the trier of fact would have to individually scrutinize the content of each allegedly infringing site" (Sur-Reply at 17) are plainly wrong.

Defendants also err in arguing that certification should be denied because some Class members may have authorized defendants to monetize their sites. A class may contain some members who ultimately have not been injured or do not wish to pursue a claim. What matters is the ability to resolve the predominating issues on a class wide basis. *See* plaintiffs' reply brief [D.E. No. 217] at 4. Here, too, defendants know which mark owners have authorized them to monetize their "www," "http" and "com" sites, because Defendants *pay* those mark owners for the right to do so. When defendants produce that list in discovery, the issue of which members of the Class were injured can be resolved on a class wide basis simply by "following the money."

V. Unjust Enrichment

Defendants' focus on the differences between state laws ignores plaintiffs' argument that the law of California should be applied to all Class members' claims. When defendants do finally address that argument (Sur-Reply at 19), they ignore the fact that Google, the center of the Deceptive Domain Scheme, is involved in every transaction at issue, making California the state that has the most significant relationship to the claims at issue – even those where a Parking Company Defendant from a state other than California is involved.

VI. Affirmative Defenses

Defendants cite a number of decisions from outside of the Seventh Circuit in which courts have considered affirmative defenses in their class certification analysis.[4] However, courts in this District have consistently refused to do so. As explained in one decision:

> It cannot be that the mere availability of an affirmative defense applicable to some but not all plaintiffs means that individual claims necessarily predominate, or defendants would have an automatic means to deny certification of virtually any class action. That is not the law.

Warnell v. Ford Motor Co., 189 F.R.D. 383, 388 (N.D. Ill. 1999).[5]

Moreover, even if this Court were to consider defendant's purported affirmative defenses, it is clear that they should not defeat class certification. Defendants have engaged in a massive scheme to profit from Deceptive Domains – at the expense of Class members – and any hypothetical affirmative defenses which defendants may assert against a small number of those Class members should not result in the loss of the class vehicle for the remaining Class members. Defendants' purported affirmative defenses – fraudulent registration, abandonment and use of a mark to misrepresent goods and service – are indeed hypothetical at this stage of the litigation. Those defenses are asserted in defendants' answers in only the most generic terms, with absolutely no specific allegations to support them,[6] and defendants have provided no support in

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4 Defendants' only case from within the Seventh Circuit, *Clark v. Experian Information, Inc.*, 233 F.R.D. 508, 512 (N.D. Ill. 2005), cites as authority only one other case – *Lilly v. Ford Motor Co.*, 2002 WL 507126 (N.D. Ill. April 3, 2002). The *Lilly* decision, however, says nothing about affirmative defenses.

5 See additional support in plaintiffs' reply brief [D.E. No. 217] at 12.

6 *See* Google's Answer to the TAC [D.E. No. 195] at 117; Dotster's Answer to the TAC [D.E. No. at 193] at 111; Oversee's Answer to the TAC [D.E. No. 192] at 94; Sedo's Answer to TAC [D.E. No.

their briefing. Moreover, should defendants ever provide support for their affirmative defenses against any Class members, this Court is empowered by Rule 23 to postpone litigation on those affirmative defenses until after the common liability issues have been resolved. As explained in *Merk v. Jewel Food Stores Div.*, 702 F. Supp. 1391 (N.D. Ill. 1988):

> A court's power under the rule is not so limited that [it is] forced to decide at this stage of the litigation whether the affirmative defenses as to certain individuals in the putative class mandate either their exclusion from this lawsuit or outright denial of certification. [Courts] are given broad discretion in the class action context, and may exercise that discretion with considerable flexibility in order to assure fairness to the parties and to promote the efficient resolution of all disputes arising out of a transaction or set of circumstances.
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> Rule 23 provides . . . a general authorization to "prescrib[e] measures to prevent undue repetition or complication." Rule 23(d). Courts have not been reluctant to devise a litigation procedure that allows a class action to proceed despite early perceived certification problems as long as all of the requirements of Rule 23 are ultimately satisfied at later stages in the litigation. Thus, a court may delay narrowing the class by fashioning appropriate procedures, such as a split trial, and deferring the disposition of uncommon issues . . . If at a later point in the litigation it is apparent that modification of the class is necessary or advised, the court may then exclude certain members or certify a subclass.

Merk, 702 F. Supp. at 1395 (citations omitted).

VII. Ascertainment Methodology

Defendants misstate that "most of the named plaintiffs' claims do not fit within [the "www," "http" and "com"] ascertainment methodology." (Sur-Reply at 23).[7] The websites "wwwvulcangolf.com" and "wwwfishernuts.com" are both specifically identified by plaintiffs.

194] at 144-45. Notably, IREIT does not even plead fraudulent registration, abandonment or use of a mark to misrepresent goods and service in its answer. [D.E. No. 191].

[7] Defendants also use this section of their Sur-Reply to rehash their original points regarding purported intra-class conflicts that supposedly defeat class certification, but they provide no new arguments or support. Plaintiffs rely on their reply brief [D.E. No. 217 at 23-24] with respect to these sections of the Sur-Reply.

TAC at ¶65. Further, the fact that websites that violate the ACPA with respect to the two other named plaintiffs' marks by pre-pending a "www" or "http" or post-pending a "com" do not appear within the TAC does not mean that such sites have not been parked and monetized by Defendants. *See* TAC at ¶65 (Deceptive Domains identical or confusingly similar to named plaintiffs' marks "includ[e] but [are] not limited to" those listed). In fact, defendants did park and monetize sites that fall within the proposed ascertainment methodology with respect to the other two named plaintiffs: "wwwblitzrealtygroup.com" and "wwwbojackson.com." *See* screenshots attached hereto as Exhibit A (both clearly showing "google" in the URL line of the clicked-through advertisement). Thus, defendants' ascertainment argument regarding the named plaintiffs is demonstrably false. Plaintiffs are confident that, once discovery is permitted, examples of domains parked by Ireit and Sedo that fall within the ascertainment methodology will also be uncovered. However, even if they are not, a class may still be certified against Ireit and Sedo. See opening brief [D.E. No. 197] at 30-33 (standing and juridical link arguments).

Dated: October 29, 2008 FOOTE, MEYERS, MIELKE & FLOWERS, LLC

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